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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,360	09/25/2003	Yun-Woo Nam	277/017	3357

7590

05/01/2006

LEE & STERBA, P. C.
Suite 2000
1101 Wilson Boulevard
Arlington, VA 22209

EXAMINER

VINH, LAN

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/669,360

Applicant(s)

NAM ET AL.

Examiner

Lan Vinh

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 4-7, 18-20 and 30.
Claim(s) rejected: 1-3, 8-17 and 21-29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 081005
13. ☐ Other: _____.

Lan Vinh
AU 1765

DETAILED ACTION

Response to Argument

Response to Arguments with respect to Polla and Ma

1. Applicant's arguments with respect to the rejection(s) of claims 1-3, 9-17 under 35 U.S.C 103(a) based on Polla and Ma are not persuasive

The applicants argue that the Examiner is mis-applying the law regarding motivation to combine, and respectfully submit that the Examiner failed to set forth a prima facie case of obviousness because in the outstanding Office action, the Examiner indicated that the motivation to combine the Polla et al. and Ma et al. references comes from Ma (Ma discloses that a substrate of a MEMS device can be a flexible substrate such as polymer, thin glass or silicon." However, applicants respectfully submit that the mere disclosure of a flexible substrate is insufficient to establish a motivation to combine. In particular, applicants note that the relevant inquiry is not whether the Ma et al. reference discloses a flexible substrate, but rather whether one of ordinary skill in the art would desire to combine the Ma et al. and Polla et al. references in order to arrive at the claimed invention. In addition, establishing motivation requires the Examiner to demonstrate why one skilled in the art, absent the teaching of applicants application would want to replace the silicon substrate of the Polla reference with the flexible substrate of the Ma reference. This argument is unpersuasive because of the following reasons: It is noted that the MPEP& 2143 also states:

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

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(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination". Thus, one skilled in the art reading Ma, as a whole, would also have noticed that Ma, in col 3, also discloses that "the ability to fabricate the MEMS controlled OLED pixels on a flexible or rigid substrate affords substantially versatility depending on the particular application or operating environment". Thus, it is asserted that one skilled in the art reading Ma, as a whole, would have desired to combine Ma and Polla in order to arrive at the claimed invention. In addition, one skilled in the art, absent the teaching of applicants application would have wanted to replace the silicon substrate of the Polla reference with the flexible substrate of the Ma reference because Ma discloses that "the MEMS can be fabricated on flexible substrates, such as thin glass or silicon, polyester (e.g. Mylar) (Ma establishes the equivalency of silicon, polyester as a flexible substrate) and it is also noted that "However, substitution of equivalents require no express motivation as long as the prior art recognizes the equivalency. In re Fount 213 USPQ 532 (CCPA 1982); in re Siebentritt 152 USPQ 618 (CCPA 1967)". Based on the above reasonings, it is asserted that the examiner has provided an objective teaching that demonstrate why one skilled would combine Polla and Ma references

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Vinh whose telephone number is 571 272 1471.

The examiner can normally be reached on M-F 8:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571 272 1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LV
April 27, 2006